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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,515	07/16/2003	Toshihiro Sasaya	104681.03	7519

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EXAMINER

BRAUN, FRED L

ART UNIT PAPER NUMBER

2852

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/619,515	Applicant(s) SASAYA ET AL.	
	Examiner Fred L. Braun	Art Unit 2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-132 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-95 and 107-113 is/are allowed.
- 6) ☒ Claim(s) 96-106 and 114-132 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/360,515.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/16/03</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. In view of the submission of new claims 107-132 in the preliminary amendment of July 16, 2003 which differ in scope from the originally filed claims 1-16, a supplemental oath or declaration which is in compliance with 37 CFR 1.63(b)(2) and 37 CFR 1.67(b), respectively, is required.

3. Claims 96-106 and 114-132 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. ***.

With respect to claims 96-106 there appears to be no basis in the original disclosure for the method of manufacturing a projection optical system and/or an exposure apparatus which includes the steps of (1) "determining a first rotate angle"; (2) "determining a second rotate angle"; and (3) "determining a third rotate angle"; recited on lines 4-12 of base claim 96 and lines 9-14 of base claim 101, respectively, thereby rendering said claims and any claims dependent thereon as being directed to new matter. Assuming arguendo that there is basis in the original disclosure for the claim language noted supra, the terms and phrases used in the claims must find clear antecedent basis and/or support in the specification as required by 37 CFR 1.75(d)(1).

Applicants allegation on page 25 of their remarks filed on July 16, 2003 that there is basis on lines 10-16 of page 43 of their original specification for the claim language noted supra is not deemed persuasive since the terms and/or expressions used in said claims have no clear antecedent basis and/or support in the original specification noted in applicants remarks. As to claims 114-116, there appears to be no basis in applicants original specification for the apparatus, recited on lines 12 and 13 of base claim 114, and/or method steps, recited on lines 9 and 10 of base claim 116, respectively, for changing the focal length of a first optical unit and a second optical unit without moving or rotating the first and second optical units thereby constituting claims that are directed to new matter. Applicants allegation on page 25 of their remarks filed July 16, 2003 that lines 9-11 on page 14 of their original specification supports the language in base claims 114 and 116, respectively, for example, is not deemed sufficient. Claims 117-132 are considered to be directed to new matter since lines 8-12 on page 44 of applicants original specification, as alleged by applicants on page 25 of their remarks filed on July 16, 2003, fails to disclose the "pressure control unit", recited on lines 11 and 12 of base claims 117 and 119, respectively, thereby rendering said base claims and any claims dependent thereon as being directed to new matter. Moreover, the method step of controlling a pressure between constituent lenses of the projection optical system, recited on lines 8 and 9 of method base claim 124 and lines 7 and 8 of method base claim 126, respectively, is also not disclosed in applicants original specification thereby rendering base claims 124 and 126 and any claims dependent thereon as being directed to new matter. Assuming arguendo that there is basis in the

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original disclosure for the claim language noted supra, then the terms and phrases used in the claims must have clear antecedent basis and/or support in the specification as required by 37 CFR 1.75(d)(1).

4. Any inquiry concerning this communication should be directed to Fred L Braun at telephone number (571) 272-2132.

Fred L Braun
FRED L BRAUN
PRIMARY EXAMINER
ART UNIT ~~2852~~